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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/778,464 | 02/07/2001 | Jean-Paul Cano | ESSI:005CP1 | 5911 |

7590 07/30/2003
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EXAMINER

NAKARANI, DHIRAJLAL S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1773

12

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/778,464 | | CANO ET AL. | |
| | Examiner | | Art Unit | |
| | D. S. Nakarani | | 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for open language "ophthalmic lens comprising --". The originally filed specification and claims provide support for closed language "ophthalmic lens consisting of ---". Therefore invention as claimed is an open language which is not supported by the originally filed specification and it constitute new matter.

3. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for (1) the abrasion-resistant coating derived from composition of claim 12 and (2) an inorganic antireflective coating having monolayer with optical thickness of $\lambda/4$ where λ is a wavelength between 450 and 650 nm or having multilayer film comprising three layers with a combination optical thicknesses $\lambda/4.\lambda/2.\lambda/4$ or $\lambda/4.\lambda/4.\lambda/4$, respectively, or equivalent multilayer with similar optical thicknesses (see page 13, lines 21-29), does not reasonably provide enablement for any abrasion resistant coating and any antireflective coating (e.g., U.S.

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Patent 4,904,525 and Declaration of Philippe Roision). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification as filed does not teach or suggest hard coating such as organic resin coating, inorganic coating etc. All coatings have somewhat abrasion resistant. Addition of coating improves abrasion of stack over stack having no coating. The claimed invention does not claim minimum abrasion resistant. Also there is no disclosure of an anti-reflective coating other than inorganic coating.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 5, 6, 10, 11, 13, 15, 18, 20 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al (U. S. Patent 4,904,525) for the reasons of record set forth in paragraph 7 of the Office Action mailed October 11, 2002 (Paper No. 8).

6. Applicant's arguments filed April 21, 2003 have been fully considered but they are not persuasive.

In reference to rejection of claims 1-21 under 35 USC § 112 first paragraph, applicants mainly argue that the specification at page 10 lines 14 to 16 defines abrasion resistant coatings and are well known by the skilled person.

These arguments are unpersuasive because definition states that abrasion resistant coating which improves the abrasion resistant of a stack as compared to the same layer stack without

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abrasion resistant coating. Any additional layer will provide improvement. Thus Taniguchi et al's hard coat will meet that requirement. Taniguchi et al's abrasion resistant coating is also silicone based coating.

In reference to rejection of claims 1-3, 5, 6, 10, 11, 13, 15, 18, 20 and 21 under 35 USC § 103(a) as being unpatentable over Taniguchi et al (U.S. Patent 4,904,525), applicants mainly state that as per declaration of Philippe Roisin, Taniguchi et al's second fluorosilicone film cannot be considered as an antireflecting coating since all stacking include only the hard coat and the second fluorosilicone film have R_m values per face at least 4% much higher than 2.5% which is upper limit value for considering the coating as having antireflective properties.

These arguments are unpersuasive because claims 1-21 are not rejected as stated in remark over Taniguchi et al. Taniguchi et al's article is an anti-reflection optical article. Further there is nowhere in the present application stated argued upper limit of R_m values to consider the coating as having antireflective properties. There is data showing that the claimed invention has R_m values at or below 2.5%.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is 703-308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. S. Nakarani/mn
July 29, 2003


D. S. NAKARANI
PRIMARY EXAMINER